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DATE: May 9, 2006

TO: USPTO – Official Central Fax FACSIMILE NO.: 703-872-9306
TELEPHONE:

FROM: Stephen A. Terrile
Hamilton & Terrile, LLP

SUBJECT: U.S. Serial Number 09/768,434
Attorney Docket No. DC-02638
Customer No. 33438

This transmittal consists of 5 page(s), including this cover sheet.

MESSAGE:

Enclosed for filing in U.S. Serial Number 09/768,434, please find a Reply Brief (4 pages). Thank you.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Jeffrey N. Sloan, Gary W. Cobb
Assignee: Dell Products L.P.
Title: Verification of a Benefit Purchase Incident to a Computer System Purchase
Serial No.: 09/768,434 Filing Date: January 24, 2001
Examiner: John W. Hayes Group Art Unit: 3621
Docket No.: DC-02638 Customer No.: 33438

Austin, Texas
May 9, 2006

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P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF UNDER 37 CFR § 1.193

Dear Sir:

Applicants submit this Reply Brief pursuant to the Examiner's Answer mailed in this case on March 27, 2006. It is believed that no fees are due in connection with the filing of this Reply Brief, however, the Commissioner is authorized to deduct any amounts required for this Reply Brief and to credit any amounts overpaid to Deposit Account. No. 502264.

In response to Applicant's arguments, the Examiner set forth:

Regarding claims 1 and 14: On page 7 of the brief, Appellant asserts, "Challenger does not disclose or suggest a purchase verification method which uses a service tag as Claimed by both independent Claims 1 and 14. Applicant's submit that log-in tokens as set forth by Challenger do not disclose or suggest the use of service tags as defined and used in the application and Claims of the present application." On the previous pages of the brief the Appellant has gone into great detail regarding the intended structure of the service tags. However, Appellant does not transfer this explicit language into the claims. With regard to the Applicant's assertions that the prior art of record does not fairly teach or disclose each and every limitation contained within the claims, it appears as if the Applicant is reading limitations into the claims from the specification. Ergo, the Examiner has taken the broadest and most reasonable interpretation of the claim limitations as written, in light of the specification. Although the specification may contain recitations of intended use, alternative points of view and subjective interpretative differences between the prior art

of record and the present invention as premeditated, it is the claims themselves that are given patentable weight only inasmuch as they are constructed. Because the claimed invention has been painted with the broad stroke of petitioning for limitations that encompasses more than is asserted in the Applicant's claims, the prior art of record continues to fully disclose the Applicant's inventions as claimed (Examiner's Answer, Page 10).

Applicants respectfully submit that there is no need to transfer the "explicit language" of the term "service tag" into the claims as it is Applicants position that service tag is a term of art which means a persistent value which uniquely identifies a particular computer system. The portions of the application to which Applicants cited were intended to support this assertion. Accordingly, the "log-in tokens" discussed in Challenger neither disclose nor suggest a service tag as defined in the present application.

Regarding claims 2, 3, 8, 9, 10, and 20: On page 13 of the brief the Appellant notes that the Examiner has based his rejection on the combination of Challenger and Official Notice, and on page 14 of the brief appears to dispute this rejection. Subsequently, the common knowledge declared to be well-known in the art is hereby taken to be admitted prior art because the Appellant either failed to traverse the Examiner's assertion of Official Notice or failed to traverse the Examiner's assertion of Official Notice adequately. To adequately traverse the examiner's assertion of Official Notice, the Appellant must specifically point out the supposed errors in the Examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. A general allegation that the claims define a patentable invention without any reference to the Examiner's assertion of Official Notice would be inadequate. Support for the Appellant's assertion of should be included. Appellant has accomplished none of these steps (Examiner's Answer, Pages 10-11).

Applicants position is that whether or not the specific items for which Examiner took Official Notice are known, the combination of these items with the cited references were not suggested. Additionally, even if the items for which Examiner took Official Notice are known, the combination of Challenger and this Official Notice does not disclose or suggest the invention as claimed in claims 2, 3, 8, 9, 10 and 20.

Regarding claims 4 and 11: On page 17 of the brief, Appellant asserts, "As discussed in detail above, Challenger does not disclose or suggest a purchase verification method which uses a service tag as Claimed by independent Claims 4 and 11. Applicant's submit that log-in tokens as set forth by Challenger do not disclose or suggest the use of service tags as defined and used in the application and Claims of the present application. Additionally, merely replacing the log-in tokens as set forth by Challenger with a service tag as disclosed by Collagen does not disclose or suggest the invention as Claimed." As

noted above, Appellant does not transfer this explicit language into the claims. With regard to the Applicant's assertions that the prior art of record does not fairly teach or disclose each and every limitation contained within the claims, it appears as if the Applicant is reading limitations into the claims from the specification. Ergo, the Examiner has taken the broadest and most reasonable interpretation of the claim limitations as written, in light of the specification. Although the specification may contain recitations of intended use, alternative points of view and subjective interpretative differences between the prior art of record and the present invention as premeditated, it is the claims themselves that are given patentable weight only inasmuch as they are constructed. Because the claimed invention has been painted with the broad stroke of petitioning for limitations that encompasses more than is asserted in the Applicant's claims, the prior art of record continues to fully disclose the Applicant's inventions as claimed (Examiner's Answer, Page 11).

As discussed above, Applicants respectfully submit that there is no need to transfer the "explicit language" of the term "service tag" into the claims as it is Applicants position that service tag is a term of art which means a persistent value which uniquely identifies a particular computer system. The portions of the application to which Applicants cited were intended to support this assertion. Accordingly, the "log-in tokens" discussed in Challenger neither disclose nor suggest a service tag as defined in the present application.

In response to Applicant's arguments, the Examiner set forth:

Regarding Claims 5 - 7: On page 17 of the brief, Appellant asserts, "Additionally, Challenger and Colligan do not disclose or suggest certain features of Claims 5-7. More specifically, Challenger and Colligan do not disclose or suggest a service tag used as claimed where the service tag is stored as part of a computer system BIOS as required by Claim 5; a second message authorizing a purchaser to receive the benefit if the service tag matches as required by Claim 6; or, the benefit being an Internet Service Provider service as required by Claim 7. The Examiner flatly disagrees with this assertion and points to the rejections of claims 5-7 above (Examiner's Answer, Pages 11-12).

The term service tag is discussed above. Storing the service tag within the computer system BIOS provides a further distinction over the "log-in token" disclosed by Challenger and the service tag claimed in the present application.

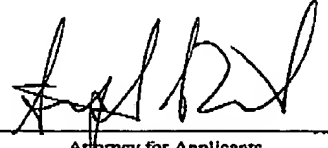
In response to Applicant's arguments, the Examiner set forth:

Regarding Claims 12 and 13: On page 18 of the brief, Appellant asserts, "Additionally, Challenger and Colligan do not disclose or suggest certain features of Claims 12 and 13, More specifically, Challenger and Colligan do not disclose or suggest storing a product code identifying a benefit as required by Claim 12 or communicating with a remote

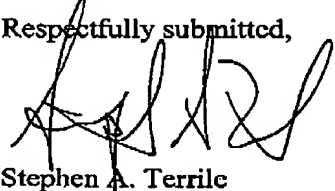
server having the ability to verify the service tag as required by Claim 13." The Examiner flatly disagrees with this assertion and points to the rejections of claims 12 and 13 above. In addition, the common knowledge declared to be well-known in the art is hereby taken to be admitted prior art because the Appellant either failed to traverse the Examiner's assertion of Official Notice or failed to traverse the Examiner's assertion of Official Notice adequately. To adequately traverse the examiner's assertion of Official Notice, the Appellant must specifically point out the supposed errors in the Examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. A general allegation that the claims define a patentable invention without any reference to the Examiner's assertion of Official Notice would be inadequate. Support for the Appellant's assertion of should be included, Appellant has accomplished none of these steps (Examiner's Answer, Issue 1, Page 12).

Applicants position is that Challenger and Colligan do not disclose or suggest the elements as discussed with respect to claim 11 along with the combination of the elements of claims 12 and 13.

For the above reasons as well as those set forth in the Appeal Brief, Applicants respectfully submits that the Examiner's rejections of Claims 1 – 20 are unfounded and should be reversed.

I hereby certify that this correspondence is being transmitted via facsimile to the USPTO on May 9, 2006.	
	5/9/06
Attorney for Applicants	Date of Signature

Respectfully submitted,


Stephen A. Terrile
Attorney for Applicants
Reg. No. 32,946